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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,834	03/05/2002	Keitaro Aoshima	003510-123	4828

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT PAPER NUMBER

1752

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,834

Applicant(s)

AOSHIMA, KEITARO

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10, 13 and 17-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-27, 29-40 and 42-47 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 13, 17-21, 28, 41 is/are rejected.
- 7) ☒ Claim(s) 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The examiner has reviewed applicant's amendments to the specification submitted on January 6, 2004 and found no reason to object to entry of said amendments.
2. Applicant's amendments of January 6, 2004 with respect to claim 18 have removed issues of clarity set forth by the examiner in the last Office Action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8, 28 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The planographic plate of claim 8 requires that the aqueous alkali solution-soluble polymer "is a copolymer" and that the copolymer is "a copolymer comprising a compound including contained in the copolymer in an amount of 10 mol% or more." The use of "is" here excludes from the aqueous alkali solution-soluble polymer all but the "copolymer". The copolymer has to have a compound, i.e. a copolymer, "including at least one acidic group". Thus, the copolymer is a copolymer with at least one copolymer in an amount of 10 mol% or more" of acidic group according to this wording. The specification on page 15 does not disclose such an arrangement. On page 15, with focus on the third paragraph, appears to disclose that 10 mol% or more is in reference not to a compound part of the composition called a "copolymer" but instead to a compound to be copolymerized to form the copolymer.

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Claim 8 does not clearly state this. Claim 8 is confusing because the clarity as to what is 10 mole% of what 100 mole%. The specification at page 15 does not reference a free monomer in admixture with a copolymer. Claim 8 does not clearly state what the compound is. Is it the entire copolymer with other possible copolymers being mixed in? Is it the monomer used to make the copolymer? Thus, the lack of clarity with respect to claim 8 remains. The same problem is introduced in newly presented claims 28 and 41.

6. Claim 41 is objected to because of the following informalities: There is a stray marking in line 2 around part of the misspelled copolynier. This word should be copolymer and there should be no alteration as is now present in claim 41. Appropriate correction is required.

7. Applicant's amendments to claims 3 and 7 submitted January 6, 2004 have removed issues of clarity with respect to 35 USC 112, second paragraph set forth by this examiner in the last Office Action.

8. The examiner notes for the record that applicants have not presented a certified English translation of their priority document. Thus, the effective filing date perfected in this application is March 5, 2002. Applicant cannot rely upon the foreign priority papers to overcome any rejection of record earlier than this filing date because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-10, 13, 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauck (US 6,55,291 or WO 02/14071 A1) in view of Rousseau (4,228,232) further in view of Smith (3,729,313) and Crivello (405841 or 4058400). Hauck discloses the instant planographic printing plate precursor with the use of phenolic or sulfonamide polymers in his top coat layer. The top layer is not described in reference to a contact angle but instead is required to be developable in aqueous base developer with the imaged material being removed and the non

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imaged material remaining. It is the top layer that is ink receptive, i.e. hydrophobic. In col. 13 under Image Formation, the image formed is positive leaving the top layer as it was in its unexposed state, after development the plate is overall cured if a negative-working base soluble photosensitive composition is the underlayer. Hauck discloses the use of photopolymerizable and photocrosslinkable negative working base soluble photosensitive composition under layers with photothermal conversion materials which are preferably not in the top layer. Hauck does not disclose the use of onium or sulfonium salts as photoinitiators in the photopolymerizable and photocrosslinkable negative working base soluble photosensitive composition under layers. However in col. 8, lines 46-54, Hauck does disclose using free radical initiating agents that activatable in ultraviolet and/or visible regions of the spectrum from 300 to 800 nm. While onium salts are not given as preferred examples, the use of such is well known in the art as set forth by Rousseau in col. 10, lines 17-50, with equivalence for this purpose being also shown for many of the compounds cited by Hauck as useful. Rousseau lists diazonium, iodonium and sulfonium free radical initiators and cites Smith and Crivello as showing this use of said free radical initiators as known in the art. Thus, with respect to instant claims 1-3, 5-10, 13, 17-21, the thermal digital lithographic printing plates of Hauck wherein the negative-working base soluble photosensitive composition is the underlayer are obvious in view of their use in the examples and the use of photopolymerizable elements in the a negative-working base soluble photosensitive composition is obvious because they are taught to be so used and the use of well known equivalent free radical photoinitiators inclusive of sulfonium, iodonium and diazonium salts as set forth by Rousseau further supported by Smith and Crivello. In Hauck, see

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particularly claims, examples, abstract, and particularly "Negative-Working Base Soluble Photosensitive Compositions".

9. Applicant's arguments filed January 6, 2004 have been fully considered but they are not persuasive. Applicants argue that Hauck does not teach the subject matter of any of the claims now of record. The examiner agrees that Hauck did not teach the use of onium salts as set forth in original claim 12. Prior art has been added to the rejection to correct this error. This action is not made final because of this. Applicants argue that Hauck is substantially different than the instant invention with respect to the functions of their respective layers. Applicants argue that their top layer is required to be removed by development but that the top layer of Hauck can remain in one embodiment. Applicants argue a limit which is not part of the instant claimed invention under rejection. Hauck allows that their top layer have present a second polymeric material that is typically insoluble in the aqueous alkaline developer used but is that the second polymeric material typically used is comprised of a phenolic hydroxy groups among others wherein these phenolic resins are light-stable, water-insoluble, and aqueous alkaline developer soluble. See in Hauck, col. 10, "Top Layer". In col. 14, lines 25-42, the top layer is removable by the developer of Hauck but less so than the regions exposed to irradiation. Thus, the top layer of Hauck acts as required by instant claims 1-3, 5-10, 13, 17-21. The rejection stands as modified.

10. Claims 22-27, 29-40 and 42-47 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-3331. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Cynthia Hamilton', written in a cursive style.

Cynthia Hamilton
Primary Examiner
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May 31, 2004

CYNTHIA HAMILTON
PRIMARY EXAMINER